



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------------|------------------|
| 10/560,947 | 12/15/2005 | Jean Kadouche | REGIM3.3-072 | 6541 |
| 530 7590 03/28/2008 LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090 | | | EXAMINER SAUNDERS, DAVID A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1644 | |
| | | | MAIL DATE | DELIVERY MODE |
| | | | 03/28/2008 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/560,947

Applicant(s)

KADOUCHE ET AL.

Examiner

David A. Saunders

Art Unit

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-48 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

CLAIMS PENDING

The amendment of 2/15/05 has been entered. claims 1-48 are pending and subject to an election of species as set forth infra.

ELECTION OF SPECIES

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

- I. an automated method for in vitro screening, wherein there are prior steps of bringing a dendritic cell(s) and a compound of interest (antigen) into contact, immunizing an animal(s) with the contacted dendritic cells, and recovering antibody producing cells from the immunized animal(s).

- II. an automated method for in vitro screening, wherein there is use of a prescreening module.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The claims are deemed to correspond to the species listed above in the following manner:

- I. Claims 8-9, 32-35 and 37
- II. Claims 38-40 and 44-48.

The following claim(s) are generic: 1-7, 10-31, 36 and 41-43.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons:

In order for there to be Unity of Invention, there must be a single contribution over the prior art. If the invention lacks novelty or an inventive step, there is no contribution over the prior art and thus a lack of Unity of Invention. Instantly the ISA has found anticipating art against originally filed claims 1-7 and 10-31. The ISA has also found prior art that indicates that claims 8-9 (claims of species I) lack an inventive step.

If applicant considers that the single contribution of the invention is an automated method, as recited in base claim 1, then the invention of Species I is properly considered to be an unrelated, add-on method. The prior steps of bringing a dendritic cell(s) and a compound of interest (antigen) into contact, immunizing an animal(s) with the contacted dendritic cells, and recovering antibody producing cells from the immunized animal(s) constitute a series of steps that cannot be automated. As such they do not represent the same contribution to the art as claim 1, because they can be conducted prior to an automated method of screening antibody producing cells, or they can be conducted prior to a conventional method of screening antibody producing cells. These steps are thus either i) an add-on of something conventional in the art, or ii) a separate contribution from the automated method of base claim 1. If applicant

Art Unit: 1644

considers that these steps constitute a contribution over the prior art and thus argue that these claims do have an inventive step, then applicant should elect Species I.

Then invention of Species II, is properly considered to represent a different contribution over the prior art than that of claim 1. While these claims pertain to automated methods, they pertain to method steps conducted prior to the automated method steps of claim 1. Since, all of the claims of Species II were added after the International Stage, they were never searched. Therefore, their examination constitutes an excess burden added onto the examination at this National Stage.

It is noted that Claims 32-35 and 37 of Species I and all of Claims 38-40 and 44-48 of Species II have been added at the National Stage. The addition of Claims 32-35 and 37 appears to be an attempt to add on features that might render claims 8-9 of Species I as having an inventive step, not shown in the art found by the International Stage examiner. The addition of Claims 38-40 and 44-48 appears to be an attempt to add-on features that might render claims 1-7 and 10-31 as novel and as having an inventive step, over the art found by the International Stage examiner. Since the non-automated steps of Species I and the automated steps of Species II represent different contributions over the prior art, applicant is required to elect one of Species I or II.

ADVISORY TO APPLICANT

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

CONTACTS

Any inquiry concerning this communication from the examiner should be directed to David A. Saunders, whose telephone number is 571-272-0849. The examiner can normally be reached on Mon.-Thu. from 8:00 am to 5:30 pm and on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen O'Hara, can be reached on 571-272-0878. The fax phone number for the organization where this application is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Typed 3/25/08 DAS

/David A Saunders/

Primary Examiner, Art Unit 1644